

#### REMARKS

The Office Action dated October 26, 2004 has been received and carefully studied.

An RCE is filed concurrently herewith.

The Examiner rejects claims 9, 12 and 13 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the newly added limitation "discrete regions separately removable from said base", when combined with the limitations of the instant claims, could be interpreted as "discrete regions having sub-regions separately removable from the base", which is not supported by the original disclosure.

The rejection is respectfully traversed.

The disclosure at page 17 with respect to Figure 7 recites that tubes 507 can be removable from the removable insert 506. This is an express example of a subregion (tubes) being on a discrete region (insert 506) being separately removable from the base.

The Examiner rejects claims 1-4 and 7-13 under 35 U.S.C. §102(b) as being anticipated by Kroy, et al., U.S. Patent No. 5,252,294. The Examiner states that Kroy discloses a device having all of the limitations of these claims.

By the accompanying amendment, claim 1 has been amended to recite that the utilitarian discontinuities are spaced a multiple of 25.5 mm. Support for the amendment can be found at page 7, of

the specification, where a multiple of 4.5 is disclosed, and where conformance with SBS guidelines is disclosed. Those guidelines recite appropriate dimensional specifications for spacing of 96 well plates (9 mm), 384 well plates (4.5 mm) and 1536 well plates (2.25 mm). This spacing is consistent with SBS guidelines, thereby enabling automation.

Kroy teaches a micromechanical structure having various cavities, depressions, humps, canals, etc. for chemical analysis of samples. There is no disclosure or suggestion in Kroy to space utilitarian discontinuities a multiple of 2.25 mm as now claimed.

In addition, Applicants respectfully submit that Kroy does not teach a structure having utilitarian discontinuities in discrete regions with different functionalities. Kroy teaches micromechanical structure that can be used for a variety of different tests, but does not teach multiple functionalities within the same structure.

The Examiner also rejects claim 5 under 35 U.S.C. §103(a) as being unpatentable over Kroy et al. in view of Sarrasin, U.S. Patent No. 5,009,780. The Examiner admits that Kroy does not disclose an ultrafiltration membrane for the filter, but cites Sarrasin as teaching such membranes for multi-well plates.

Claim 5 is believed to be allowable by virtue of its dependence, for the reasons stated above with respect to claim 1.

The Examiner rejects claims 1-4 and 11 under 35 U.S.C. §103(a) as being unpatentable over Mathus, U.S. Patent No.

5,972,694 in view of Kroy. The Examiner states that Mathus teaches a device having a surface comprising multiple spatially discrete regions having utilitarian discontinuities having different functionalities, but does not teach discrete regions separately removable from the base. The Examiner cites Kroy as teaching this feature.

Mathus discloses a multi-well cluster plate having a plurality of wells and a plurality of access ports, wherein each access port is associated with a respective well in order to provide direct access to the lower chamber of the corresponding well, such as with a pipette. Applicants respectfully disagree with the Examiner's combination of Kroy to deprecate the claimed invention. No motivation has been provided to make a discrete region in Mathus (i.e., the well 26 or access port 28) separately removable from the base. The passage at column 8, lines 1-10 of Kroy relied upon by the Examiner for the separately removable limitation relates to macrochips that are cemented or fastened detachably on a film carrier 23 that is transported. In no way does this suggest to the skilled artisan to make the wells and access ports of the multi-well plate of Mathus separately removable. No basis has been provided for any suggestion or motivation in the cited references to so modify Mathus. See *In re Rouffet*, 47 U.S. P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) ("To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner

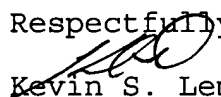
to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed."). No such showing has been made.

The Examiner also rejects claims 1, 2 and 9-13 under 35 U.S.C. §102(e) as being anticipated (sic, 35 U.S.C. §103(a) as being unpatentable over) by Nguyen et al. in view of Kroy. The Examiner states that Nguyen teaches multiple discrete regions and sub-regions, but does not teach that they are separately removable. The Examiner again cites Kroy as teaching this limitation.

As was the case with Mathus, there is no suggestion or motivation to modify Nguyen et al. in view of Kroy and make a discrete region separately removable from the base.

Reconsideration and allowance are respectfully requested in view of the foregoing.

Respectfully submitted,

  
Kevin S. Lemack  
Reg. No. 32,579  
176 E. Main Street - Suite 7  
Westboro, Massachusetts 01581  
TEL: (508)898-1818